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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/099,785 | 03/15/2002 | Steven M. Goetz | 11738.00057 | 4871 |
| 22907 | 7590 | 03/28/2005 | EXAMINER | |
| BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001 | | | WONG, ALBERT KANG | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2635 | |

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/099,785 | Applicant(s) GOETZ ET AL. | |
| | Examiner Albert K Wong | Art Unit 2635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-35 is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/26/02, 8/25/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. This Office action is in response to the application filed March 15, 2002. Claims 1-35 are pending. It is suggested that applicant amend the specification to include the current application number for the applications referenced in the specification. The formal drawing filed June 5, 2002 have been approved by the Examiner.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-3, 17-18, and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2 and 17, it is not clear how the recited step relates to the previously recited steps. Further, the step alone does not appear to accomplish any purpose.

Regarding claims 3 and 18, which protocol driver is the claim referring to?

Regarding claim 24, a protocol driver is software. It is not clear how a driver can "receive" a signal.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-16, and 19-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ryan 5,350,411.

Regarding claim 1, Ryan teaches an implantable telemetry system with a programming tool wherein the programmer and the implantable device are in communication with each other. The devices may be programmed with one protocol among the plurality available. Inherent in such a system is a transmit and a receive driver to enable proper communication using a compatible protocol. Alternatively, it would have been obvious to configure a driver so that the receiver and transmitting devices may communicate with each other. A driver is merely a piece of software that enables proper communication. This may be the prestored program or the code that enable the selection of one of the stored programs.

Regarding claims 4-6, Ryan teaches that the protocol may be any modulated pulses which would include states and modulation schemes.

Regarding claims 7-8, the same parameters associated with the transmitter would also have been true for the receiver. It would have been obvious that the transmitter and receiver parameters must be similar to enable communication.

Regarding claims 9-11, it would have been obvious to halt communication if something is preventing the reception of data. Some common things that prevent communication is if the memory is full, a timeout condition (due to inability to communicate), or if the communication is completed.

Regarding claim 12, Ryan teaches the communication between a programming and an implantable device. Inherent within the transmission scheme is a selected protocol. See claim 1 above. This claim is essentially the transmission portion of claim 1.

Regarding claims 13-15, these limitations have been addressed above.

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Regarding claim 16, this claim corresponds to steps c and d of claim 1. See rejection to claim 1 above.

Regarding claims 19-23, these limitations have been addressed above.

Regarding claim 24, Ryan teaches a programmer and an implantable device which communicate with each other using a selected protocol. Inherent in such a system is a protocol driver to produce the necessary signals that is understood by both devices. The output of the driver is signals with a specific parameter as determined by the driver. See claim 1 above.

Regarding claims 25-26, the host in Ryan is the programmer which has a processor for interfacing with the driver.

Regarding claim 27, any general purpose computer may assume the functions of a computing device designed for one processing purpose. It would have been obvious to use a general purpose computer to take advantage of existing software (i.e. operating system) available on the computer.

6. Claims 29-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Claims 31-35 are allowed.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is suggested to consider all of the prior art cited prior to preparing a response.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 571-272-3057. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Albert K. Wong
March 15, 2005